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REMARKS

With regard to the drawings, the Examiner states that "there is no reference sign in Figure 1B." Applicant does not understand what the Examiner means, and requests further clarification.

With regard to the drawing objection under 37 CFR §1.83(a), it is believed that this limitation is already depicted in Figure 8. The Examiner's attention is directed to the apparatus involving a rotating dielectric 806, positioned between opposing plates 802 and 804. It would be apparent to anyone of skill in the art that neither plates 802 nor 804 occupy an entire radial area around the axis of rotation. Accordingly, Applicant does not believe a change to the drawings is necessary, but will add text to the specification, should the Examiner require such language.

With regard to the claim rejections, Applicant had made the changes proposed by the Examiner, and appreciates the apparent careful reading of the claims. With regard to the claim rejections under 35 U.S.C. §112, the language "to measure movement in X and Y directions" has been removed in claim 8. As per claims 25 and 26, it should be apparent that "neither plate" refers to the electrically conductive capacitor plates, because the non-circular dielectric is "an element." Again, Applicant respectfully requests further guidance should this continue to be deemed insufficient.

Claims 25 and 26 stand rejected under 35 U.S.C. §102(b) over Shahoian. The Examiner's arguments notwithstanding, "stationary" has been added before the "electrically conductive capacitor plates" in claim 25. It is noted that according to Shahoian, the dielectric 107 is actually bonded to one of the movable electrodes 110, a physical configuration which is structurally and functionally different from that of Applicant. While Applicant does not believe the word "stationary" needs to be added to claim 25, since the capacitor plates are "supported on either side of the dielectric element," Applicant respectfully requests that the proposed change be entered, if only for the purposes of Appeal.

Claims 1-3, 5-7, 10-12 and 14-26 stand rejected under 35 U.S.C. §103(a) over Shahoian, and further in view of Baker et al. ('704). Beginning with claims 1, 2 and 22, it appears to Applicant that the Examiner's basic premise is wrong. According to the Examiner, "the difference between the Shahoian reference and the invention defined in claims above is a stationary [sic] of the signal detecting capacitor plate." That is part of the difference, but perhaps more importantly, is that Applicant uses a *moving dielectric* between two stationary plates. Note Applicant's claim 1, for example, wherein the signal-detecting capacitor plate and the signal-transmitting capacitor plate *are both stationary*. The

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dielectric element, however, is clearly movable, as a member is used to laterally shift the element in the X or Y directions in a plane substantially parallel to the stationary plates as a function of user position. Shahoian et al. neither teach nor suggest any such structure or function and, in fact, in all of the embodiments of Shahoian, not only does an electrically conductive plate, but a dielectric plate is either attached to the movable plate or the stationary plate. See, for example, column 4, lines 45-48.

Given this basic misunderstanding, the Examiner goes on to argue that it would have been obvious "to utilize Baker's teaching and the device of Shahoian, i.e., providing Shahoian's the signal detecting capacitor plate being stationary, because this would prevent wide voltage fluctuations and variations in the signals to be sensed between the signal detecting capacitor and the electronics circuit, occurred due to the movement of the signal detecting capacitor plate, thereby producing an accurate position of the user manipulandum [sic] or joystick handle." As best understood, Applicant's respectfully disagree on the grounds that the motivation to combine has nothing to do with the theory postulated by the Examiner, but rather, must come from the prior art itself. In rejecting claims under 35 U.S.C. § 103, the Examiner must provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art, or to combine references, to arrive at Applicant's claimed invention. There must be something in the prior art that suggests the proposed modification, other than the hindsight gained from knowledge that the inventor choose to combine these particular things in this particular way. Uniroyal Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988). The Examiner is also required to make specific findings on a suggestion to combine prior art references. In Re Dembeczak, 175 F.3d 994, 1000-01, 50 USPQ2d 1614, 1617-19 (Fed. Cir. 1999).

In this case, Shahoian et al. propose a perfectly reasonable physical structure to carry out possession sensing by face shift sensing using a variable capacitor, namely, the use of a moving electrically conductive plate, and a dielectric bonded either to that plate or to an opposing stationary plate. Although Baker et al. disclose a dielectric, it is in the form of a cylindrical body 140 disposed in the annular space defined by a pair of concentrically spaced electrodes. The dielectric body 140 includes a radially extending disc-shaped section 143 and a rod member 145. The disc-shaped section 143 and rod member 145 are integrally formed with the cylindrical portion of the dielectric body 140. (See '704 patent, column 3, lines 11-16.) Not only can Applicant find no teaching or suggestion

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whatsoever that the combination of Shahoian and Baker "would prevent wide voltage fluctuations ... occurred due to the movement of the signal-detecting capacitor plate ...," there is no motivation to combine these references apart from Applicant's own disclosure, and even if the references were to be combined, there is no way of knowing what the practical result would be.

Moreover, even if the Shahoian/Baker combination were legitimate, Applicant's invention would not result, since claim 1, for example, includes language whereby a member is operative to laterally shift the dielectric element in a plane substantially parallel to the stationary plates as a function of user position. Such capability is entire taught nor suggested by either reference. Accordingly, the Examiner has failed to establish *prima facie* obviousness.

Given that independent claim 1 should be allowable, dependent claims 2, 3 and 5-10 should be deemed allowable as well. As per claim 11, the same logic applied to claim 1 applies here as well, in that the signal-detecting capacitor plate and signal-transmitting capacitor plate are both recited as "stationary," with a movable dielectric disposed therebetween. Thus, some of the same distinctions made in comparing claim 1 to the Shahoian/Baker combination apply here as well, with additional limitations that are neither taught nor suggested by the prior art.

Based upon the foregoing amendments and comments, Applicant believes all claims continue to be in condition for allowance. Questions regarding this application can be directed to the undersigned attorney at the telephone/facsimile numbers provided.

Respectfully submitted,

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